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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,764	11/29/2001	Masaki Nakamura	56232.13 [4925]	6474

7590

02/01/2005

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EXAMINER

MANLOVE, SHALIE A

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,764

Applicant(s)

NAKAMURA ET AL.

Examiner

Shalie A. Manlove

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-34 is/are pending in the application.
4a) Of the above claim(s) 9-33 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 6, 8 and 34 is/are rejected.
7) ☒ Claim(s) 4 and 5 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Rejections Repeated

Claim Rejections - 35 USC § 103

1. Claims 1-3, 6, 8, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aida (US 6,235,099).

As to claims 1-3, Aida teaches inkjet recording liquid (abstract) and process for the production thereof comprising a pigment derivative having a polar group (col. 5, lines 18-64) and pigment particles (col. 4, lines 1-42) ranging from 0.01 to 0.1 microns or 10-100 nm (col. 3, lines 28), and a surfactant (col. 9, line 66) dispersed in a dispersion medium (see examples). A prima facie case of obviousness typically exists when the range of a claimed composition overlap the range disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

As to claim 6, Aida teaches a surfactant is added for the purpose of maintaining the dispersion of the pigment (col. 9, lines 63-65). It is well known in the art that the surfactant would adsorb on the surface of the pigment particles to decrease agglomeration amongst the particles.

As to claim 8, Aida teaches water-based or water-dispersed inkjet recording liquid to contain at least 50% water (col. 9, lines 15-18; col. 11, lines 12-19, 26-36 and col. 12, lines 27-35, and 42-51).

As to claim 34, Aida teaches the inkjet recording liquid comprising a pigment derivative with a polar group (col. 5, lines 50-64).

Art Unit: 1755

2. Claims 4-5 are objected to as being referred to a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. The following is a statement of reasons for the indication of allowable subject matter:
The prior art of record fails to teach the pigment dispersion as claimed.

Response to Arguments

Applicant's arguments filed 5/17/2004 have been fully considered but they are not persuasive.

Applicant argues, "Aida fails to obvious that the particles are precipitated as recited in amended claim1".

Newly amended Claim 1 has been rewritten as a product by process claim, which is a product claim not a process claim. Presently, claim 1 has been given little to no patentable weight.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Art Unit: 1755

Applicant has not shown how precipitated pigment particles are different from the Aida's pigment particles. Hence, the reference meets the limitation of claims 1-3, 6, 8, and 34.

Conclusion


4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1755


Shalie A. Manlove
Examiner
Art Unit 1755

January 26, 2005

A
SARALISA KOSLOW
JURY EXAMINER